



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,383	01/25/2001	Kevin Delos Parris	2368/12	6452
7590	03/02/2004		EXAMINER	
Craig J. Arnold, Esq. Amster, Rothstein & Ebenstein 90 Park Avenue New York, NY 10016			LY, CHEYNE D	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

847.

## Office Action Summary

Application No.

09/771,383

Applicant(s)

PARRIS ET AL.

Examiner

Cheyne D Ly

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-17, 19-21 and 35-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-17, 19-21 and 35-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: <u>February 12, 2004</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicants' arguments filed January 31, 2004 have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. This is a NON-FINAL Office Action.
3. Applicant's summary of the January 22, 2004 telephone interview has been accepted.
4. Claims 15-17, 19-21, and 35-84 are examined on the merits.

### **LACK OF ENABLEMENT UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 15-17, 19-21, and 35-84 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of utilizing a crystal structure of ACPS having a RMS of 1.66A (page 34, lines 4-21), does not reasonably provide enablement for a method of utilizing a crystal structure of ACPS having a RMS of not more than 1.5A; or not more than 0.5A or 1.0A, as directed to claims 46-67. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Art Unit: 1631

7. Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in *Ex parte Forman*, 230 USPQ 546 (BPAI 1986) and reiterated by the Court of Appeals in *In re Wands*, 8 USPQ2d 1400 at 1404 (CAFC 1988). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2) the amount or direction presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. The Board also stated that although the level of skill in molecular biology is high, the results of experiments in genetic engineering are unpredictable. While all of these factors are considered, a sufficient amount for a *prima facie* case is discussed below.

8. It is acknowledged that Applicant has disclosed information to enable one skilled in the art to make a specific crystal for the method of utilizing a crystal structure of ACPS having a RMS of 1.66Å (page 34, lines 4-21). However, the instant specification does not provide adequate disclosure for one of skill in the art to make a crystal structure of ACPS having a RMS of not more than 1.5Å, 0.5Å, or 1.0Å to practice the claimed invention. It is well known in the art (Drenth, pages 93-95) that the accuracy with which a structure can be determined depends strongly on the resolution of the diffraction pattern. Due to the fact that atoms of proteins vibrate around an equilibrium position, X-rays do not meet identical atoms on exactly the same in successive units cells (unpredictability). The parameters that effect the accuracy with which a structure can be determined are “dynamic disorder” which is influenced by temperature; and “static disorder” which is influenced by intrinsic properties (size, parts of molecules, and flexibility) of the respective molecule (atoms) being crystallized. Therefore, one of skill in the art

Art Unit: 1631

would not know how to crystallize an ACPS having a RMS of not more than 1.5A, 0.5A, or 1.0A without knowing the precise “dynamic disorder” and “static disorder” parameters being used accomplish such tasks.

9. Further, as recently as November 1, 2002, Science published a New Focus article depicting the current state of the art for protein crystallization that supports the unpredictability of the art. In essence, protein crystallization is still a trial and error process because the current technology for producing protein for the crystallization process is unpredictable, which results in high failure rate for proteins that are being crystallized. Therefore, researchers continue to have trouble generating sufficient protein required for the crystallization process (New Focus, Science, 2002).

10. Accordingly, one of skill in the art would not know how to predictably make crystal structures ACPS having a RMS of not more than 1.5A; or not more than 0.5A or 1.0A to practice the claimed invention without undue experimentation.

### **CONCLUSION**

11. NO CLAIM IS ALLOWED.

12. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 872-9306.


Art Unit: 1631

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

15. Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina Plunkett, whose telephone number is (571) 272-0549 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

C. Dune Ly  
2/27/04

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER